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PATENT
Customer No. 22,852
Attorney Docket No. 7707.0020-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Michael K. MAXWELL et al.) Group Art Unit: 1732
Serial No.: 10/000,148) Examiner: Stefan Staicovici
Filed: December 4, 2001)
For: A MOLDED COMPOSITE)
STRUCTURE AND METHOD OF)
FORMING SAME)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated September 29, 2003, Examiner M. J. Carrone required restriction under 35 U.S.C. § 121 between Group I (Claims 1-21, 43, 45-66, and 89), Group II (Claims 22-42, 44, 67-88, and 90), and Group III (Claims 91-100). On October 17, 2003, Applicants responded to this restriction requirement by electing to prosecute the claims of Group I. On February 18, 2004, the present Examiner, however, withdrew the previous restriction requirement and issued a new restriction requirement requiring restriction under 35 U.S.C. § 121 between Group I (Claims 1-21 and 45-66), Group II (Claims 22-42, 44, 67-88, and 90), Group III (Claims 91-100), and Group IV (Claims 43 and 89). For the reasons stated below, Applicants respectfully traverse the restriction requirement between Groups I and IV and request that it be withdrawn so that Applicant will be able to elect the claims of Groups I and IV together.

The Examiner asserts that claims 1-21 and 45-66 (Group I) and claims 43 and 89 (Group IV) are "unrelated" because the "different inventions of those claims have different functions and modes of operation." The Examiner further asserts that "the positive process steps of the molding process of Group 1 are unrelated either in function or mode of operation to the mathematical code of the computer readable medium of Group IV." Applicants respectfully traverse the Examiner's restriction for the following reasons.

The claims of Group I and Group IV are clearly related. In fact, claims 43 and 89 recite a computer readable medium containing instructions for controlling a computer system to perform methods that are identical to those recited in Claims 1 and 45, respectively. Since these claims recite the exact same method, they are related and cannot be restricted from one another according to the restriction practice set forth in the MPEP.

In the Office Action, the Examiner cited M.P.E.P. §§ 806.04 and 808.01 and asserted that "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." (emphasis added). Rather than being so unrelated, however, **the present application illustrates that the subject matter of the claims of Group I and the subject matter of the claims of Group IV are capable of being used together.** As explained in M.P.E.P. § 808.01, a factual situation supporting a restriction requirement such as that proposed by the Examiner is "**rarely presented**, since persons will seldom file an application containing disclosures of independent things." (emphasis added). Inasmuch as the present application illustrates how the subject

matter of the claims of Groups I and IV may be used together without necessarily being independent of one another, the restriction requirement should be withdrawn.

Finally, even if the claims of Groups I and IV could be considered independent, “[i]f the search or examination of [the] application can be made without serious burden, the examiner must examine it on the merits.” MPEP § 803 (emphasis added). The searches for each of Groups I and IV would necessarily overlap one another due to the common claimed subject matter. Thus, the examination of these claims together would not result in any additional burden to the Examiner. Consequently, the restriction requirement between Groups I and IV is improper and should be withdrawn.

For all the above stated reasons, Applicants respectfully request that the Examiner withdraw the restriction requirement between claims 43 and 89 of Group IV and claims 1-21 and 45-66 of Group I so that Applicants will be able to elect Groups I and IV together. If the Examiner agrees to that modification, Applicants provisionally elects to prosecute Groups I and IV. If, on the other hand, the Examiner insists on maintaining the restriction requirement and refuses to modify it as suggested, Applicants provisionally elects Group I with traverse and respectfully requests that the Examiner make the restriction final as soon as possible so that Applicants will have an opportunity to file a petition requesting the Group Director to review the restriction requirement.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 12, 2004

By: 

D. Brian Kacedon
Reg. No. 46,814